

Remarks

Claims 1, 6 and 7, stand rejected under 35 U.S.C. 102(b) as being anticipated by Lundstrom (WO 97/04245). Applicant respectfully asks the Examiner to reconsider this rejection in view of the following Remarks.

Applicant respectfully submits that Lundstrom does not anticipate the claimed invention because all claims require "a hydraulic piston under the control of an electrically controlled throttle or pressure valve," a differential clutch pump "for supplying hydraulic pressure to the hydraulic piston," and "a feeder pump for maintaining a certain base pressure in the system." Lundstrom is directed to a device for transmitting torque between two rotatable shafts including pistons (55-57), a clutch (12,14), a pump (35), and a throttle valve (38). (Fig. 3, page 8, l. 14-27). The Examiner maintains that the combination of piston elements 55-57 qualifies as a clutch pump and that this clutch pump is a differential pump. (page 3). If piston elements (55-57) are considered a differential pump, as suggested by the Examiner, then Lundstrom would still fail to anticipate the claimed invention because it would then lack a hydraulic piston as required by all claims. Applicant respectfully submits that since Lundstrom does not disclose the combined elements of a hydraulic piston, a clutch pump, and a feeder pump, Lundstrom does not anticipate the claimed invention.

Further, Applicant respectfully submits that Lundstrom does not render the claimed invention obvious because there is no motivation or suggestion to modify or apply Lundstrom in accordance with the claimed invention.

It is well settled that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir.

1990). Construing elements 55-57 in Lundstrum as a clutch pump means that Lundstrum fails to disclose a hydraulic piston. To satisfy this requirement, requires a second hydraulic piston to be incorporated into Lundstrum. The objective of Lundstrum is to transmit torque between two rotatable, coaxial shaft members. It does so utilizing a throttle valve that supplies pressurized oil from a pump to a piston, which engages a clutch. This decreases the rotational speed differential between the shafts. Since the elements of a throttle valve, pump, piston (or differential pump), and clutch accomplish the objective of Lundstrum, one skilled in the art would not be motivated by Lundstrum to incorporate a second piston. Such a piston would only provide a redundant function to the piston/differential pump 55-57 in Lundstrum. In fact, it is doubtful that such a configuration is possible. If the piston/differential pump 55-57 is rectifying the rotational speed differential between to co-axial shafts, it is unclear how a second piston could be incorporated into the system such that it rectifies the same shafts. As a result, one skilled in the art would not be motivated to modify Lundstrum to incorporate "a hydraulic piston under the control of an electrically controlled throttle or pressure valve," a differential clutch pump "for supplying hydraulic pressure to the hydraulic piston," and "a feeder pump for maintaining a certain base pressure in the system."

It is also well settled that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The piston/differential pump 55-57 acting upon cam rollers and clutch discs in Lundstrum accomplish the function of rectifying the rotational speed differential between co-axial shafts. Adding a second piston to Lundstrum would mean that the piston/differential pump 55-57 would no longer accomplish this function. Thus, the piston/differential pump 55-57 would no longer accomplish its intended function. As a result, one skilled in the art would not be motivated by Lundstrum to incorporate "a hydraulic piston under the control of an electrically controlled throttle or pres-

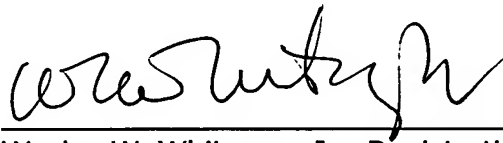
sure valve," a differential clutch pump "for supplying hydraulic pressure to the hydraulic piston," and "a feeder pump for maintaining a certain base pressure in the system."

Finally, it is well settled that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). As noted above, adding a second piston would mean that the piston/differential pump 55-57 in Lundstrum would no longer accomplish the function of rectifying the rotational speed differential between co-axial shafts. Such a modification would change the principle by which the rotational speed between co-axial shafts is rectified in Lundstrum. Instead of piston/differential pump 55-57 rectifying the rotational difference, it would be a second hydraulic piston. Thus, the purpose of piston/differential pump 55-57 as disclosed in Lundstrum would be nullified. As a result, one skilled in the art would not be motivated by Lundstrum to incorporate "a hydraulic piston under the control of an electrically controlled throttle or pressure valve," a differential clutch pump "for supplying hydraulic pressure to the hydraulic piston," and "a feeder pump for maintaining a certain base pressure in the system."

For the foregoing reasons, Applicant respectfully submits that all pending claims are patentable over the references of record, and earnestly solicits allowance of the same.

Respectfully submitted,

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